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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,956	03/11/2004	Larry E. Wittmeyer JR.	000409-0167	4878

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STINSON MORRISON HECKER LLP
ATTN: PATENT GROUP
1201 WALNUT STREET, SUITE 2800
KANSAS CITY, MO 64106-2150

EXAMINER

AHMAD, NASSER

ART UNIT PAPER NUMBER

1772

DATE MAILED: 04/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/797,956

Applicant(s)

WITTMAYER, LARRY E.

Examiner

Nasser Ahmad

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) 1-44 and 54-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-53 and 63-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. It is noted by the examiner that the preliminary amendment filed on October 4, 2005 apparently crossed in the mail with the Office Action of October 4, 2005. As such, this Office Action is being made non-final.

Rejections Withdrawn

2. Claims 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaye (5390819) made in the last Office Action has been withdrawn in view of the amendment filed on January 30, 2006.

3. Claims 48-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaye in view of James (2415012) made in the last Office Action has been withdrawn in view of the amendment filed on January 30, 2006.

Response to Arguments

4. Applicant's arguments with respect to claims 45-53 and newly presented claims 63-70 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 45-47, 68 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaye (5390819).

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Kaye relates to a method of using a stack of flexible sheet (10). The method comprising providing a stack of non-foldable sheets (30) disposed in a stack, with adhesive disposed on alternate opposite edges of successive paper or plastic sheets in the stack, and spreading the stack so that at least a portion of the flexible sheets are positioned such that successive sheets touch each other at the areas of adhesive but does not contact said sheets otherwise in the areas where there is not adhesive (figures 4 and 6). The adhesive provides for peel resistance when the sheets are pulled from the stack and the resistance would provide for curl resistance. The method also comprises spreading the stack of sheets so at least a portion of the stack of sheets are positioned such that the second major surface of a first sheet touches the first major surface of successive adjacent sheet in the areas where the sheets are adhered by the adhesive but the second major surface of the first sheet does not otherwise substantially contact the first major surface of a successive sheet where there is no adhesive. However, Kaye fails to teach that the stack is used a recreational toy. It would be obvious to one having ordinary skill in the art to modify Kaye by providing the stack of sheet as a recreational toy because, as shown in figures 4 and 6, the stack is spread into an accordion-like toy, which would provide for entertainment and recreation to the user. Spreading the sheets into an arcuate or semi-circular form would have been obvious design choice modification of shape of the sheets of Kaye for providing aesthetic appeal.

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7. Claims 48-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaye in view of James (2415012).

Kaye, as discussed above, fails to teach that the spreading is performed by having a user place one end of the stack in the palm of one hand and the other end on the palm of the other hand. James discloses a method of using a spreadable stack as a recreational toy. As shown in figures 3-5, the method comprises placing the two ends of the stack on the two palms of the two hands and moving the hands up and down. Figure-7 shows that the stack is permitted to expand downwardly from an upper surface to a lower surface, and/or move to a third surface. Therefore, it would have been obvious to one having ordinary skill in the art to utilize James' teaching of placing the ends of the expandable stack on a palm or surface and permitting it to expand to a lower palm or surface in the invention of Kaye with the motivation to provide amusement to the user.

8. Claims 63-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaye.

Kaye, as discussed above, fails to teach that the peel adhesion between successive sheet is at least 150g when the sheets are pulled laterally at 180 degrees. It would have been obvious to one having ordinary skill in the art to modify Kaye, because the adhesive sheets of Kaye do have certain adhesive strength and, providing adhesion strength of at least 150g when the sheets are pulled laterally at 180 degrees would have

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been obvious optimization through routine experimentation for holding the sheets together in a stack prior to spreading.

Response to Arguments

9. Applicant's arguments filed January 30, 2006 have been fully considered but they are not persuasive.

Applicant argues that Kaye's stack of sheets cannot be used as a toy because it is solely used with a dispenser. This is not deemed to be persuasive because, as shown in figures 4 and 6, the stack can be spread into an accordion forming shape, which would provide for amusement to the user and hence, would function a toy.

Contrary to applicant's argument that figures 4 and 6 of Kaye do not teach a recreational toy, the above explanation apply *a fortiori* herein. Once the stack is expanded or spread into said shape of figures 4 and 6 of Kaye, it would obviously amuse the user by drawing the user's attention thereto.

Similarly, as discussed in the preceeding paragraphs, the forming of semi-circular or arcuate shape would have been obvious design choice modification of the shape.

Regarding the peel strength, rendering the peel strength in Kaye to be at least 150g (as recited in claim 63), it would have been obvious optimization through routine experimentation, to hold the sheets together in a stack.

In response to applicant's arguments that the combination of Kaye and James does not make out a prima facie case of obviousness, applicant is informed that James was cited to show that the steps of moving the user's both hands up and down is well known in

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the toy art and would have been obvious to one having ordinary skill in the art to use said steps for Kaye's stack of sheets for providing amusement to the user.

Further, contrary to applicant's position, the reference of Kay and James provides for the method steps of spreading the article using the hand movement and thus suggest the method of use steps as claimed.

In response to applicant's argument that Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgement on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned from applicant's disclosure, such a reconstruction is proper. *In re MacLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, it is well known in the toy art to use the steps of moving both hands up and down for moving an accordion shaped article, such as the stack of sheets of Kaye.

Thus, in the absence of any evidence to the contrary, it remains the examiner's position that the claimed invention is obvious over the prior art of record discussed above.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nasser Ahmad 4/12/06
Primary Examiner
Art Unit 1772

N. Ahmad.
April 12, 2006.